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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,085	07/10/2000	John R. Ehrman	STL9-2000-0069	9432

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INTERNATIONAL BUSINESS MACHINES CORP
IP LAW
555 BAILEY AVENUE, J46/G4
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EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

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DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,085

Applicant(s)

EHRMAN, JOHN R.

Examiner

CESAR B PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This action is responsive to the amendment filed on 3/17/2004.

This action is made Final.

2. In the amendment, claims 1-12 are pending in the case. Claims 1, 5, and 9 are independent claims.

Information Disclosure Statement

3. Applicant indicates that the references alleged missing from related application 10/613,083 are contained in the IDS filed herewith on 2/2/2001 (page 6, lines 7-9). The correct number of the related case in question is 09/613,083. This case is a separate and distinct application from this application herein. According to 37 CFR 1.98(a)(2), each IDS filed with an application shall include a legible copy of each publication listed in the IDS. Therefore, the applicant is required to file the non-patent references with the case in question wherewith the IDS was filed.

Drawings

4. The drawings filed on 7/10/2000 have been accepted by the examiner.

Claim Objections

5. Claims 3, 7, and 11 have been amended to correct previous objections. Therefore, the objections have been withdrawn.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Edberg et al, hereinafter Edberg (Pat. # 5,793,381, 8/11/1998, as disclosed by the applicant on 2/2/2001).

Regarding independent claim 1, Edberg teaches a code converter stored in a computer readable medium for converting non-Unicode strings to Unicode by looking up a mapping table—*retrieving a specification code page*-- containing the Unicode or “second character encoding”, and the non-Unicode string character for converting to Unicode (col.3, lines 42-61, col.4, lines 10-67, and col. 11, line 47-col.12, line 67).

Furthermore, Edberg teaches a code converter stored in a computer readable medium for converting non-Unicode strings—*a scope*-- to Unicode (col.3, lines 42-61, and col.4, lines 10-67). Edberg fails to explicitly disclose: *specifying a portion of a computer program subject to the translation*. However, it would have been obvious to a person of ordinary skill in the art at the

Art Unit: 2178

time of the invention to have converted the portion of the computer program, because this would provide the benefit of allowing people of different nationalities to interact with the computer in a different language as taught by Edberg (col.1, lines 36-41). Thereby providing a user in a different language with the ability to interact with a program—strings—in another language.

Regarding claim 2, which depends on claim 1, Edberg teaches that the code converter converts the non-Unicode strings, such as all strings input into an email document—*global scope*-- to Unicode (col.2, lines 1-67, col.3, lines 57-61, and col.4, lines 10-67). Edberg fails to explicitly disclose: *the global scope specifying that the translation applies to an entirety of the computer program*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have converted the entirety of the computer program, because this would provide the benefit of allowing people of different nationalities to interact with the computer in a different language as taught by Edberg (col.1, lines 36-41). Thereby providing a user in a different language with the ability to interact with a program—document—in another language.

Regarding claim 3, which depends on claim 1, Edberg teaches a code converter stored in a computer readable medium for converting non-Unicode a single character or strings characters—*a constant*-- to Unicode (col.3, lines 36-61, and col.4, lines 10-67). Edberg fails to explicitly disclose: *the local scope specifying that the translation applies to a subsequent portion of the computer program*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have converted the subsequent portion of the computer

Art Unit: 2178

program, because this would provide the benefit of allowing people of different nationalities to interact with the computer in a different language as taught by Edberg (col.1, lines 36-41).

Thereby providing a user in a different language with the ability to interact with the subsequent characters in the computer program written in another language.

Regarding claim 4, which depends on claim 1, Edberg teaches a code converter stored in a computer readable medium for converting non-Unicode a single character—a *constant*-- to Unicode (col.3, lines 36-61, and col.4, lines 10-67). Edberg fails to explicitly disclose: *the constant specific scope specifying that the translation applies only to a specific constant*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have converted the constant, because this would provide the benefit of allowing people of different nationalities to interact with the computer in a different language as taught by Edberg (col.1, lines 36-41). Thereby providing a user in a different language with the ability to interact with a character—*constant*—written in another language.

Claims 5-8 are directed towards a method for implementing the article of manufacture found in claims 1-4 respectively, and therefore are similarly rejected.

Claims 9-12 are directed towards a computer system for implementing the article of manufacture found in claims 1-4 respectively, and therefore are similarly rejected.

Response to Arguments

8. Applicant's arguments filed 3/17/2004 have been fully considered but they are not persuasive. Regarding independent claims 1, 5, and 9, the applicant states that there must be some suggestion or motivation to modify the reference or to combine the teachings of the references found in the prior art, and not in the applicant's disclosure-- *hindsight reasoning* (page 9, lines 6-page 10, line 8). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned **only** from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As it has been stated by the applicant, Edberg teaches having people of different nationalities interact with a computer in different languages as found in col.1, lines 36-41 of the reference (page 8, lines 11-15 of this amendment). So then, the motivation for specifying a portion of a computer program subject to translation, comes not from applicant's disclosure, but it is rather found in the reference of record—Edberg. The fact, that the motivation seems to be very similar to that found in the disclosure is purely coincidental, and not intentional on the examiner's part.

Claims 2-4, 6-8, and 10-12 depend from independent claims 1, 5, and 9. Therefore, they are rejected at least based on their dependency status.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Akuta et al (Pat. # 6,658,645), Allen et al (Pat. 6,658,625), Silver et al. (Pat. # 6,003,050), McKenna (Pat. # 5,758,314), Gallup et al (Pat. 6,658,627), Silver et al. (Pat. # 6,204,782),

Art Unit: 2178

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

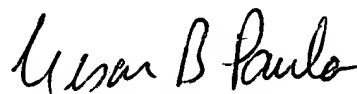
Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).



CESAR B PAULA
Patent Examiner
Art Unit 2178

5/19/04